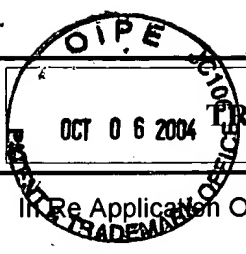


AF/2875
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TRANSMITTAL OF APPEAL BRIEF (Small Entity)	Docket No. IDS-14302/14
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In Re Application Of: Venegas, Jr.

Application No. 09/829,033	Filing Date 04/09/2001	Examiner Sawhney	Customer No. 25006	Group Art Unit 2875	Confirmation No. 8392
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Invention: **LIGHTED STANCHION COVER**

COMMISSIONER FOR PATENTS:

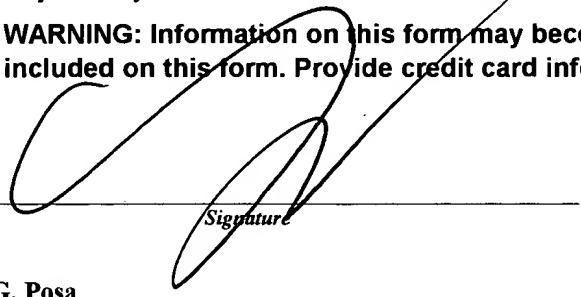
Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

☒ Applicant claims small entity status. See 37 CFR 1.27

The fee for filing this Appeal Brief is: \$170.00

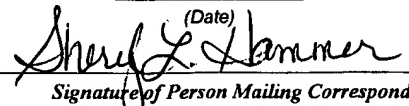
- ☒ A check in the amount of the fee is enclosed.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account.
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- ☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

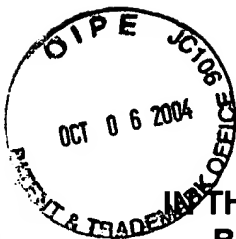

Signature

Dated: Oct. 4, 2004

John G. Posa
Reg. No. 37,424
Gifford, Krass, Groh
280 N. Old Woodward Ave., Suite 400
Birmingham, MI 48009
Tel. 734/913-9300

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>Oct. 4, 2004</u> .
 <i>(Date)</i> Signature of Person Mailing Correspondence
Sheryl L. Hammer Typed or Printed Name of Person Mailing Correspondence

CC:



THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Venegas, Jr.

Serial No.: 09/829,033

Group No.: 2875

Filed: April 9, 2001

Examiner: Sawhney

For: LIGHTED STANCHION COVER

APPELLANT'S BRIEF UNDER 37 CFR §1.192

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Frank Venegas, Jr., Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 12 claims. Claim 12 has been allowed. Claims 1-11 are under appeal.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

No after-final amendments have been filed.

V. Concise Summary of the Invention

The present invention is directed toward providing a lighted stanchion cover for a stanchion that

includes an elongated tubular body with a lighting assembly disposed within its exterior surface. In the preferred embodiment, the lighted stanchion cover provides the stanchion with illumination without sacrificing the protective barrier function of the stanchion (Specification, page 3, lines 13-17). A preferred embodiment of the lighted stanchion cover, according to the invention, includes an elongated tubular body with opposite ends, one end open and the other closed (Specification, page 3, lines 18-20). The interior cavity of the cover is dimensioned to receive the entire stanchion through its open end in slip fit engagement (Specification, page 3, lines 20-21). A lighting assembly, that includes a light and power source, is integrated within the body of the cover and is fashioned so not to interfere with reception of the stanchion into the cover (Specification, page 3, line 21 to page 4, line 2). In the preferred embodiment, the lighting assembly is designed to receive power from an external power source. A second embodiment has the lighting assembly designed to receive power from an internal power source (Specification, page 4, lines 3-5). Optionally, to improve power efficiency, an electronic circuit can be integrated into the lighting assembly for power management and control to ensure that electrical energy will only be expended under certain conditions as a method of energy conservation. Preferably, a lighted cover will be fastened to the fixed surface by use of a conventional fastening means sufficient for such purpose (Specification, page 4, lines 6-11).

VI. Concise Statement of Issues Presented For Review

1. Are claims 1-6 unpatentable under 35 U.S.C. §103 over U.S. Patent No. 5,121,307 to Moore?
2. Are claims 7-8 unpatentable under 35 U.S.C. §103 over U.S. Patent No. 5,121,307 to Moore in view of U.S. Patent No. 3,855,924 to Morse?
3. Are claims 9-11 unpatentable under 35 U.S.C. §103 over U.S. Patent No. 5,121,307 to Moore in view of U.S. Patent No. 4,819,135 to Padilla et al.?

VII. Grouping of Claims for Each Ground of Rejection Which Appellant Contends

Appellant believes the following groups of claims represent patentably distinct subject matter requiring separate consideration on appeal:

Group I: Claims 1-6, wherein claims 2-6 stand or fall with claim 1;

Group II: Claims 7 and 8 which stand or fall together;

Group III: Claims 9-11, wherein claims 10 and 11 stand or fall with claim 9.

VIII. Argument

A. Group I - Claims 1-6, wherein claims 2-6 stand or fall with claim 1.

Claims 1 stands rejected under 35 U.S.C. §103 over Moore, U.S. Patent No. 5,121,307. Claim 1 includes the limitation of a cover that receives a stanchion substantially in its entirety, such that the bottom (open) end of the cover is proximate to, or in contact with, a ground surface. This clearly distinguishes over the Moore reference.

The Moore patent is directed to a pole-mounted, self-contained, solar-powered strobe light utilizing ultraviolet rays from the sun (and moon) for charging its batteries and employing a cylindrical housing open at one end for fitting over the top of a vertically mounted pole. Batteries are insertable in the other end of the housing which are covered by a cap for closing this end of the housing. The cap has mounted on it a strobe light connected to the batteries and covered by a transparent magnifying lens (U.S. Patent No. 5,121,307, Abstract).

The housing is adapted only to fit over the top end an electric power or telephone pole (col. 2, lines 18-19). Clearly the cover of Moore could not extend down to a ground surface due to the wires and other obstacles that telephone and utility poles are designed to support. Given that obviousness cannot defeat a purpose for which a prior-art invention is intended, *prima facie* obviousness has not been established.

B. Group II - Claims 7 and 8 which stand or fall together.

Claim 7 includes the limitation that the elongated tubular body of claim 1 displays a message. This claim stands rejected under 35 U.S.C. §103 over Moore in view of U.S. Patent No. 3,855,924 to Morse. The Examiner concedes that Moore does not teach an elongated tubular body displaying a message, but proposes the Moore/Morse combination "to display messages [sic] in a simple and cost

saving manner. The Examiner's argument is not persuasive on several grounds. First, there is no teaching or suggestion from the prior art to combine these references. In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Appellant's claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner has not met this mandate.

Second, Morse is non-analogous art. "In order to rely on a reference as a basis for rejection of an Appellant's invention, the reference must either be in the field of Appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem"); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

Morse resides in a sign making stencil method. "The principle object of the invention is to provide a very simple and easily manipulable stencil which may be used selectively in one position to make an entire sign in one direction, or may be shifted indicia-by-indicia to make a sign at right angles to the first mentioned direction." (Morse, Jr., col. 1, lines 14-19) Thus, Morse is concerned with sign-making in general and orthogonal lettering in particular. Appellant's problem to be solved is that of *lighted stanchions*. But for the Examiner's unfounded arguments, the subject matter of the two inventions do no overlap.

C. Group III - Claims 9-11, wherein claims 10 and 11 stand or fall with claim 9.

Claims 9 stand rejected under 35 U.S.C. §103 over Moore in view of Padilla et al., U.S. Patent No. 4,819,135. The Examiner concedes that Moore does not disclose light-dispersing windows, a message displayed by a plurality of light sources, or light sources in the form of light-emitting diodes.

The Examiner states that it would have been obvious to modify the lighting assembly of Moore with the tubular body taught by Padilla "for benefits and advantages of eye-catching displays and for traffic safety in dark." However, Appellant disagrees for several reasons. First, as discussed above, given that the cover of Moore is intended for tops of utility poles, and the like, at distances high above the ground, the desirability of an "eye-catching display" makes little practical sense. In addition, it is well settled that in order to establish *prima facie* obviousness in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Appellant's claimed invention. There must be something *in the prior art* that suggests the proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

Furthermore, as with Morse, Padilla represents non-analogous art. "In order to rely on a reference as a basis for rejection of an Appellant's invention, the reference must either be in the field of Appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem"); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). In this case, Padilla, being directed to a bicycle lighting device bears no relation whatsoever to the problem facing Moore, or Appellant.

Conclusion

This application was originally filed in April, 2001. This is the second appeal; the Examiner withdrew the first on largely similar points of argument. For all of the arguments of record, all pending

Serial No. 09/829,033

- 6 -

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claims of the subject application continue to be in condition for allowance, and Appellant seeks the Board's concurrence at this time.

Date: Oct. 4, 2004

Respectfully submitted,

By: 

John G. Posa

Reg. No. 34,424

Gifford, Krass, Groh, Sprinkle,

Anderson & Citkowski, P.C.

280 N. Old Woodward, Suite 400

Birmingham, MI 48009

(734) 913-9300

APPENDIX A**CLAIMS ON APPEAL**

1. A lighting assembly for use with a stanchion extending outwardly from a ground surface comprising:

an elongated tubular body having an open end and a closed end defining an interior cavity, the open end and the interior cavity of the elongated tubular body being dimensioned to receive the stanchion substantially entirely therein such that the open end is proximate to or in contact with the ground surface; and

a lighting assembly, having a light source interconnected to a power source, the light assembly being secured relative to the tubular body so that the light is visible exteriorly of the interior cavity.

2. The lighting assembly of claim 1 wherein the power source is external to the lighted stanchion cover.

3. The lighting assembly of claim 2 further includes an electronic circuit for power management and control.

4. The lighting assembly of claim 3 further including a light source receptacle for receiving a lamp.

5. The lighting assembly of claim 1 wherein the power source is a plurality of photovoltaic devices that are supported by the elongated tubular body.

6. The lighting assembly of claim 1 wherein the power source is a battery.

7. The elongated tubular body defined in claim 1 wherein the body displays a message.

8. The elongated tubular body defined in claim 1 wherein the message is stenciled letters or

an image upon the body.

9. The elongated tubular body defined in claim 1 wherein the body includes one or more light dispersing windows.

10. The elongated tubular body of claim 7 wherein the message is displayed by a plurality of light sources supported by the thickness of the body.

11. The elongated tubular body of claim 10 wherein the plurality of light sources are light emitting diodes.